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APPLICATION NUMBER 08-675,665 FILING DATE 3/96 VAN DER ERST NAMED APPLICANT J PATTY DOCKET NO. 4

MM21/0819

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EXAMINER
SHINGLETON, M

ART UNIT PAPER NUMBER
2821 -16

DATE MAILED: 08/19/98

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

☒ Responsive to communication(s) filed on 8-3-1998

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), ~~or thirty days~~, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1, 2 and 4-6 ☒ are pending in the application.
Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1, 2 and 4-6 ☒ are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of Reference Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

-SEE OFFICE ACTION ON THE FOLLOWING PAGES-

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Claims 1, 2 and 4-6 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant claims that the arrangement has "reduced power loss". This makes the claims indefinite. What range of power loss are we taking about? Reduced with respect to what level?

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4-6 in so far as understood are rejected under 35 U.S.C. 103(a) as being unpatentable over Stevens in view of Tap.

Stevens discloses the basic arrangement of the present invention. This includes a DC to DC converter that "generates" a second DC voltage from the first DC voltage. This DC-DC converter has a switching element and a control circuit that controls the switching element at "high" frequency. There is also a "means II" (Now called a "second circuit".) i.e. just a plain old conventional inverter that powers a lamp. How Stevens differs involves the specific arrangement of the DC source.

Tap discloses a specific arrangement of the DC source such that the first DC source, i.e. the battery is added to the "means I" (Now called a "first circuit".) that includes a transformer and this supplies the output load. (Note that some of the power from the battery is transferred

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directly to the load without passing through the transformer.). The great advantage to adding the first DC source to the second involves the protection of such a circuit during a no load condition. With lamp circuits no load conditions are common. People have been known to remove lamps with the power still on. Also lamps have been known to break which provides a no-load condition. By unloading the inverter the DC source also becomes un-loaded presenting a dangerous condition to the converter as recognized by Tap.

Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize a DC source that adds the battery or first DC source voltage to the one that generates its DC voltage from the first DC source so as to protect against a no-load condition.

Applicant recites a "high-pressure discharge lamp" is employed. Stevens does not recite how much pressure are in his lamps. However, how "high" is "high"? Because of this and the fact that applicant does not set forth a range of pressures the pressure in Stevens lamps are seen being every much as high as that of applicant's. In any case, Stevens does recite that high intensity lamps are employed and it is well known that these have a higher pressure than your typical fluorescent lamp. Thus if applicant meant a lamp that has a higher pressure than the typical fluorescent lamp then clearly Stevens has such. If not given that Stevens discloses that an inverter can power a wide range of lamps, the use of a "high pressure" lamp clearly would have

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been obvious to one of ordinary skill for it would only be part of the workable range for that of Stevens.

Applicant also recites a "fly-back" arrangement for the DC-DC converter. Tap is seen as having such. However, fly-back arrangements for DC-DC converters are very conventional and conventional in the art. They are art recognized equivalents. As such the employment of such would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant's arguments filed 8-3-1998 have been fully considered but they are not persuasive.

Applicant has not added any further structural limitations to claim 1, applicant just added to the functional wherein statement provided at the end of the claim. The added material includes a statement that "some (of the) power" is transferred to the "secondary circuit", i.e. inverter, without passing through the transformer. When one examines figure 3 of Tap, one can clearly see that that power from the battery source travels at least two different paths. It could pass through the winding 11 of transformer 3. It likewise passes through the capacitor 14. Capacitor 14 is "very small" in value as recited by Tap. Therefore, "some" of the power from the battery is transferred directly to load without passing through the transformer. Note that the term "directly" in claim 1 does not recite a direct electrical connection, but merely recites that power from the source is applied directly to the inverter. Even in applicant's invention the current from terminal

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K1 has to pass through either capacitor C2 or the series circuit diode D and the secondary of the transformer TR to get back to terminal K2. It just happens that Tap's capacitor path is in the postive side and applicant's is in the negative side which is just an obvious rearrangement of elements which is not being claimed (See In re Japikse, 86 SPQ 70 (CCPA 1950)). Thus, Tap is in every sense of the invention presented by applicant an invention wherein some power is transferred directly to the inverter without passing through the transformer.

It is immaterial to the issue of obviousness as to where or not applicant or applicant's representative knows how to modify Stevens with the structure of Tap. Applicant is respectfully reminded that the test for obviousness is not whether the features of one reference may be bodily incorporated into the other to produce the claimed subject matter but simply what the combination of references makes obvious to one of ordinary skill in the pertinent art. See In re Bozek, 163 USPQ 545 (CCPA 1969), In re Mapelsden, 51 CCPA 1123, 329 F.2d 321, 141 USPQ 30 (1964) and In re Henley, 44 CCPA 701, 239 F.2d 3, 112 USPQ 56 (1956).

Any inquiry of a general nature or relating to the status of this application should be directed to the group receptionist whose telephone number is (703) 308-0956. Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Michael Shingleton whose telephone number is (703) 308-4903.

Shingleton
February 27, 1998
August 17, 1998

Michael B Shingleton
MICHAEL SHINGLETON
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